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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,960	07/25/2003	Ary S. Chernomorsky	RUBI5873	2271
<div>22430 7590 01/23/2008</div> <div>YOUNG LAW FIRM, P.C. ALAN W. YOUNG 4370 ALPINE ROAD SUITE 106 PORTOLA VALLEY, CA 94028</div>				
<div>EXAMINER</div> <div>DAWSON, GLENN K</div>				
<div>ART UNIT PAPER NUMBER</div> <div>3731</div>				
<div>MAIL DATE DELIVERY MODE</div> <div>01/23/2008 PAPER</div>				

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/627,960	Applicant(s) CHERNOMORSKY ET AL.	
	Examiner Glenn K. Dawson	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 40-57, 59-62, 64-69, 137-165 and 169-173 is/are allowed.
- 6) ☒ Claim(s) 1-7, 10, 12, 14-19, 21-25, 34-39, 74-78, 83-85, 87-92, 96, 97 and 166-168 is/are rejected.
- 7) ☒ Claim(s) 13, 26-33, 86, 102 and 103 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 1-7,10,12-19,21-57,59-62,64-69,74-78,83-92,96,97,102,103 and 137-173.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 166-168 are rejected under 35 U.S.C. 102(b) as being anticipated by Agrawal, et al.-6187329.

Agrawal discloses an implant having three portions (lines could be arbitrarily drawn delineating 3 different portions) which each would have differing porosities forming a porosity gradient as shown in fig. 2-7. These different porosities will lead to an inherent difference in swelling capabilities of the three portions. Additionally, a variety of different additives can be placed in the implant, including therapeutic medicines and other materials. The internal reservoir for claim 166 is simply internal voids formed by pores in the material. The material of the implant can be biodegradable and this would cause drug elution during breakdown, as well as a drug delivery rate which would vary

depending on the degree or degradation of the implant. It would be slower before breakdown of the implant and faster as the internal pores became breached. The implant can be used to treat maladies of bones, such as cancer. The material of the implant can be PLA or PGA and can include magnetic materials. See col. 4 ll 12-19,31-45,64-67; col. 6 ll 12-50 and col. 21 ll 15-32.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4,12,14-19,21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal-'329 in view of Zaffaroni-3948254.

Agrawal discloses the invention as claimed with the exception of the closed drug reservoir. Zaffaroni discloses that it was known to include a closed drug reservoir in an implant. It would have been obvious to have placed a drug or therapeutic material in a closed reservoir inside the implant of Agrawal, so that upon degradation, the therapeutic material could be released to treat, prevent or diagnose a condition of the patient.

Claims 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal-'329 in view of Zaffaroni-3948254 as applied to the claims above, and further in view of Scarborough-5676146.

Agrawal as modified by Zaffaroni disclose the invention as claimed with the exception of the radiopaque contrast media. Scarborough discloses that it was known to provide an implant with a radiopaque contrast media. It would have been obvious to have provided the implant of Agrawal as modified by Zaffaroni with such a radiopaque contrast media in order to visualize the area and implant using conventional imaging techniques following implantation.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal-'329 in view of Zaffaroni-3948254 as applied to the claims above, and further in view of Pfeil-4135935

Agrawal as modified by Zaffaroni disclose the invention as claimed with the exception of the radioactive material. Pfeil discloses that it was known to treat bone cancer or diseases with radioactive material. It would have been obvious to have provided the implant of Agrawal as modified by Zaffaroni with a radioactive material in order to treat cancer at the implantation site.

Claims 7,10,34-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal-'329 in view of Zaffaroni-3948254 as applied to

the claims above, and further in view of either Gordon-4622952, Meade, et al.-6673333, or Fodstad, et al.-6184043.

Agrawal as modified by Zaffaroni disclose the invention as claimed with the exception of the paramagnetic material. The three teaching references all disclose that it was known to use paramagnetic material and contrast media to bind to the cancer cells and show up on an MRI or other imaging scan. It would have been obvious to have provided the implant of Agrawal as modified by Zaffaroni, with paramagnetic material in order to be able to diagnose or determine the presence of cancer cells in bone marrow.

Claims 74-78,83-85,87-92,96 and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal-'329 in view of Zaffaroni-3948254 and further in view of either Gordon-4622952, Meade, et al.-6673333, or Fodstad, et al.-6184043, and further in view of Scarborough or Pfeil and Ayer-6283953.

The previous combination makes obvious the invention as claimed with the exception of the use of radiopaque materials and radioactive material. It would have been obvious to have provided an implant with these materials in order to be capable of both diagnosing and treating cancer cells at a bone

implantation site. As dyes and pigments are common contrast agents, as noted by Ayer, such would have been an obvious addition to the implant.

Claims 74-78,83-85,87-92,96 and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal-'329 in view of Zaffaroni-3948254 and further in view of Scarborough, Pfeil and Ayer-8283953.

The previous combination makes obvious the invention as claimed with the exception of the use of radiopaque materials and radioactive material. It would have been obvious to have provided an implant with these materials in order to be capable of both diagnosing and treating cancer cells at a bone implantation site. This combination does not require a paramagnetic material, only a dye or pigment. As dyes and pigments are common contrast agents, as noted by Ayer, such would have been an obvious addition to the implant.

Allowable Subject Matter

Claims 40-57,59-62,64-69,137-165,169-173 are allowed.

Claims 13,26-33,86,102,103 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

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Applicant's arguments with respect to the rejected claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn K. Dawson whose telephone number is 571-272-4694. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd E. Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Glenn K Dawson
Primary Examiner
Art Unit 3731

Gkd
18 January 2008